

Remarks

The Examiner has rejected claims 1 – 22 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 6,053,921 to Wagner et al. ("the Wagner patent"). These rejections are respectfully traversed.

Claim 1 requires a medical instrument, in particular an endoscopic instrument, with an instrument shaft, a tool positioned on the distal end of the instrument shaft, and a handle. The handle can be secured for storage on the instrument shaft by means of a coupling element in an axial extension of the instrument shaft. Moreover, the handle can be secured on the instrument shaft so that it can be moved "by at least three degrees of freedom with respect to the instrument shaft."

As described in Applicants' Specification, exemplary embodiments of the inventive medical instrument may therefore include a handle that translates along an instrument shaft and also rotates in two or more directions. Specification, ¶¶ 39 – 40. For example, in some embodiments the handle may translate along a longitudinal axis 10, and rotate about two or more of axes 10, 11, and 12. Specification, ¶¶ 39 – 40; Figs. 1 – 2.

Wagner discloses a surgical cable system including a tensioner adapted to vary the tension of the cable. This tensioner comprises a body 52 and an arm 54, with the arm 54 being pivotable about an arm pin 72 relative to the body 52. The tensioner further includes a shaft 58 extending through openings 82 and 84 of the body 52. By

means of a spring 94 and push tab 64, it is possible to move the shaft 58 through openings 82 and 84 of the body 52. Col. 11, line 14 – Col. 13, line 67; Figs. 14 – 17.

However, Wagner fails to teach or suggest that a “handle” that “can be moved by at least three degrees of freedom with respect to the instrument shaft” as required by all pending claims. It is well settled that a “claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As such, none of the pending claims can be anticipated by Wagner. Even if the Examiner considered the body 52 to be a handle, the body 52 is not rotatable about any axis and certainly cannot be moved by at least three degrees of freedom with respect to the instrument shaft as required by each of Applicants’ Claims 1 – 22.

In fact, Wagner specifically discloses a body 52 that is prevented from rotating. The shaft 58 includes “two flat edges 59 (shown in FIG. 14) that run longitudinally along the entire length of the shaft 58... giving the shaft a substantially oval shape.” Col. 12, lines 48 – 54. “Referring back to FIG. 16, the rear opening 84 of the body 52 is preferably shaped to allow a shaft 58 of complimentary shape to pass through the rear opening... [and is] preferably shaped to inhibit rotation of the shaft 58 within the body 52.” Column 12, lines 54 – 59. As such, it is impossible to move the body 52 disclosed in Wagner in more than one degree of freedom.

Because Wagner fails to teach each and every element of Claim 1, none of the Claims 1 – 22 can be anticipated by Wagner. Furthermore, because Wagner specifi-

cally teaches away from a medical device having a rotatable handle, no combination of prior art with Wagner can render any of the claims 1 – 22 obvious since a prima facie case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

For the foregoing reasons, it is respectfully submitted that claims 1 – 22, all of the claims remaining in the application, are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,



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